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REMARKS

Upon entry of this Response, claims 1-6, 12, and 14-18 remain pending in the present application. Claims 7-11 have been canceled herein without prejudice or disclaimer as being drawn to a non-elected invention in the present application. Applicants expressly reserve the right to pursue the subject matter of claims 7-11 in a divisional application. Claim 13 has been canceled herein without prejudice or disclaimer. Applicants expressly reserve the right to pursue the subject matter of claim 13 in a continuation application. Applicants respectfully request reconsideration of the pending claims in view of following remarks.

In item 10 of the Office Action, claims 1, 3-5, 13, 15-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,496,276 issued to Dei et al. (hereafter "Dei"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Claim 13 has been canceled herein, thereby rendering this grounds of rejection moot with respect to claim 13. Applicants respectfully assert that Dei fails to show or suggest each of the elements of claims 1, 3-5, and 15-17 for the reasons that follow. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, claim 1 provides as follows:

1. A printing method, comprising:
 - relaying a non-rendered document from a local printer to a host coupled thereto, the non-rendered document being received in the local printer from a portable device via a portable device communications port;
 - identifying one of a number of applications in the host that is compatible with the non-rendered document;
 - rendering the non-rendered document with the one of the number of applications into a format compatible with the local printer, thereby creating a rendered document; and
 - sending the rendered document to the local printer for printing.

With respect to claim 1, in item 11, the Office Action states that:

"Dei teaches a printing method, comprising: relaying a non-rendered document (print data from still camera 12: (col. 3, line 61) from a local printer [1, FIG. 2] to a host [9, Fig. 2] coupled thereto, the non-rendered document being received in the local printer from a portable device [12, FIG. 2; col. 4, lines 50-55] via a portable device communications port [6, FIG.2];

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Rendering the non-rendered document into a format compatible with the local printer (print data coming from the host being printed by the printers; col. 1, lines 47-54: hence print data coming from the host being compatible with the printer), thereby creating a rendered document (processed print data: col. 4, lines 5-6); and

Sending the rendered documents to the local printer for printing (col. 4, lines 6-12).

Dei does not explicitly teach identifying one of a number of applications in the host that is compatible with the non-rendered document, and using the identified application to render the non-rendered document.

It was, however, well known in the art at the time the invention was made for a user of a host to process print data (to render a non-rendered document) using one of a number of local printer compatible applications. It would have been, therefore, obvious to one of ordinary skill in the art at the time the invention was made for the user to identify one of the local printer compatible applications to process print data for the purpose of printing the print data in a format most appealing to the user." (Office Action, pages 4-5).

Applicants respectfully disagree. Applicants note that the camera described in Dei provides "pictures" of a single format that would be communicated to the host for printing on the printer as described. In this manner, software may be stored in the host that is compatible with the camera and the format of the pictures for rendering the pictures in a format for printing on the printer as described. Thus, such an application would provide for the communication between the digital camera. Thus, the computer system described in Dei does not have to search through a number of applications to identify one that is compatible with the non-rendered document.

In contrast, the portable device as described with reference to the present application may be a device other than a digital camera such as, for example, a personal digital assistant or other such device. As such, these devices may include documents of many different formats, as opposed to the digital camera as described in Dei which would generally only generate pictures within a single format and would only require a specific application on the computer for rendering for printing. Thus, in this respect, Dei teaches away from the concept of identifying a particular application in the host that is to be used for rendering a document received from the portable device. This is because the portable device of Dei only shows or suggests that documents of a single format will be communicated to the computer system for

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printing on the printer as described therein. There is not need to identify an application as such.

In addition, the Office Action admits that Dei fails to show or suggest identifying one of a number of applications in the host that is compatible with the non-rendered document. In this respect, the Office Action states that it is "well known in the art at the time the invention was made for a user of a host to process print data (to render a non-rendered document) using one of a number of local printer compatible applications" and that it "would have been, therefore, obvious to one of ordinary skill in the art at the time the invention was made for the user to identify one of the local printer compatible applications to process print data for the purpose of printing the print data in a format most appealing to the user."

Applicants respectfully disagree. Given that the Office Action admits that Dei fails to show or suggest identifying one of a number of applications in the host that is compatible with the non-rendered document", it is apparent that the rejection of claim 1 in this respect is based upon facts within the personal knowledge of the Examiner.

When a rejection in an application is based on facts within the personal knowledge of an examiner, it should be specific as possible. When called for by the applicant, the examiner must support the assertion with an affidavit which is subject to contradiction or explanation by the affidavits of the applicant or other persons. 37 CFR 1.104(d)(2). Accordingly, Applicant requests that the Examiner provide an affidavit attesting to the assertions that it is "well known in the art at the time the invention was made for a user of a host to process print data (to render a non-rendered document) using one of a number of local printer compatible applications" and other pertinent facts relied upon to generate the grounds of rejection in the Office Action. Otherwise, Applicant asserts that the rejection of claim 1 based upon the personal knowledge of the Examiner is improper.

Thus, for the above reasons, Applicants respectfully request that the rejection of claim 1 be withdrawn. In addition, Applicants request that the rejection of claims 3-5 be withdrawn as depending from claim 1.

5. The printing method of claim 1, further comprising the step of rendering the non-rendered document with the one of the number of applications into the format compatible with the local printer further comprises launching the one of the number of applications in

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the host with instructions to print the non-rendered document using the local printer.

With respect to claim 5, the Office Action states:

"Dei teaches ... the processed print data being supplied to the printing unit (col. 4, lines 6-10), hence launching the identified application in the host with instructions to print the document using a local printer-claim 5". (Office Action, page 5)

Applicants respectfully disagree. Dei merely states that the personal computer processes the print data from the electronic still camera. In this respect, Dei shows or suggests a dedicated approach to rendering documents for printing based on the receipt of images from the still camera. In this respect, the processing capability of the computer presumably is dedicated to rendering the pictures from the still camera. In this respect, there is no need to provide instructions to a given application to render a document for printing since the only function of the processing capability of the computer of Dei is presumably to render the document for printing on the associated printer.

In contrast, a number of applications may be stored in the host according to the various embodiments of the present invention, where each application is generally executed by a user, for example, when they wish to create a document, etc. Such applications are not dedicated applications in the sense that they do not automatically execute and render a document for printing on an automatic basis because they are not dedicated for such functionality. As such, instructions are provided to the application at the time it is launched according to various embodiments of the invention so as to cause the application not only to launch, but to render the document for printing accordingly. In contrast, no instructions need to be provided to the sole application that performs the processes of Dei since such an application necessarily is dedicated for the specific function of rendering a picture for printing on the printer. Accordingly, Applicant asserts that Dei fails to show or suggest each of the elements of claim 5.

Thus, Applicants assert that the rejection of claim 5 is improper. Accordingly, Applicants request that the rejection of claim 5 be withdrawn. In addition, claim 17 has been amended herein so as to appear in independent form. To the extent that claim 17 includes subject matter similar in scope with that of claim 5, Applicants request that the rejection of claim 17 be withdrawn as well.

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In addition, with respect to claims 15 and 16, Applicants note that claims 15 and 16 have been amended herein to depend from claim 14. To the extent that claim 14 includes subject matter similar in scope with that of claim 1, Applicants request that the rejection of claims 15 and 16 be withdrawn as depending from claim 14 for the reasons discussed above with respect to claim 1 to the extent applicable.

Next, in item 15 of the Office Action, claims 1-5 and 12-17 have been rejected under 35 U.S.C. §103(a) as being obvious over US Patent Application Publication US/2002/0129097A1 (Serial Number 09/799,381) by Jia. Applicants note that claim 13 has been canceled herein, thereby rendering this grounds of rejection moot with respect to such claim. In addition, claim 14 has been amended solely to incorporate the subject matter of claim 13. Also, claims 15-16 have been amended so as to depend from claim 14, and claim 17 has been amended solely to appear in independent form incorporating the subject matter of claim 13 canceled herein. Thus, the substance of claims 14 and 17 remains unchanged from when originally filed.

Applicants assert that the rejection of claims 1-5, 12, and 14-17 is improper as US Patent Application Publication US/2002/0129097A1 is disqualified as a reference as provided by 35 U.S.C. §103(c).

Specifically, 35 U.S.C. §103(c) provides:

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

US Patent Application Publication US/2002/0129097A1 qualifies as prior art only under §102(e). Given that the invention that is the subject of the present application and the subject matter of US Patent Application Publication US/2002/0129097A1 were owned by the same entity at the time the present invention was made, then US Patent Application Publication US/2002/0073399 is disqualified as prior art under §103. In this respect, a statement is provided in the following section that at the time of the invention of the present application was made, both the subject matter of US Patent Application Publication US/2002/0129097A1 and the present invention that is the subject of the present

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Patent Application were owned by, or subject to an obligation of assignment to, the same person or entity.

In view of the fact that US Patent Application Publication US/2002/0129097A1 is hereby disqualified for use as a prior art reference under §103, Applicants assert that the rejection of claims 1-5, 12, and 14-17 as being unpatentable over US Patent Application Publication US/2002/0129097A1 is improper. Accordingly, Applicants request that the rejection of claims 1-5, 12, and 14-17 over US Patent Application Publication US/2002/0129097A1 be withdrawn.

STATEMENT OF COMMON OWNERSHIP UNDER 35 U.S.C. §103(c)

Applicants hereby state that both the subject matter of US Patent Application Publication US/2002/0129097A1 and the present invention that is the subject of the present Patent Application were, at the time the present invention was made, owned by the same person or entity, or subject to an obligation of assignment to the same person or entity.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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